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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/622,652	11/28/2000	Jan Koeppen	10191/1520	3139
26646	7590	11/03/2004	EXAMINER PHAN, HANH	
KENYON & KENYON ONE BROADWAY NEW YORK, NY 10004			ART UNIT 2633	PAPER NUMBER

DATE MAILED: 11/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/622,652

Applicant(s)

KOEPPEN ET AL.

Examiner

Hanh Phan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 November 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 10/28/2004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 22-42 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-21 of U.S. Patent No. 6,583,898 (Koeppen et al). Although the conflicting claims are not identical, they are not patentably distinct from each other because the limitations recited in claims 22-42 of the instant application are encompassed by claims 1-21 of U.S. Patent No. 6,583,898 (Koeppen et al).

Regarding claims 22 and 36, Koeppen (US Patent No. 6,583,898) discloses a method for transmitting useful optical signals, comprising the steps of:

providing an optical transmission device between a first transceiver and a second transceiver, the first transceiver including at least one of a first signal source and a first signal sink, the second transceiver including at least one of a second signal source and

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a second signal sink, the optical transmission device including at least one normal segment and at least one alternative segment, the at least one normal segment and the at least one alternative segment running parallel;

intercoupling the at least one normal segment, the at least one alternative segment, the first transceiver and the second transceiver via at least two coupling nodes;

generating, receiving and recognizing optical test signals section by section via at least four test signal nodes, the optical test signals being in addition to the useful optical signals and including at least a first type of the optical test signals, a second type of the optical test signals and a third type of the optical test signals, the third type including the optical test signals that are not of the first type and not of the second type, the at least four test signal nodes including at least two test signal nodes and at least two additional test signal nodes, the at least two test signal nodes being arranged at ends of the at least one normal segment, the at least two additional test signal nodes being arranged at ends of the at least one alternative segment;

transmitting the optical test signals via the optical transmission device;

detecting a disturbance of the optical transmission device by receiving the third type via a test signal node of the at least four test signal nodes; and switching over between the at least one normal segment and the at least one alternative segment via the at least two coupling nodes,

wherein the step of switching over between the at least one normal segment and the at least one alternative segment includes the step of switching over from a particular

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normal segment to a particular alternative segment via a particular coupling node, the particular coupling node being coupled to a closest test signal node of the particular normal segment via a control unit, and

wherein the step of switching over from the particular normal segment to the particular alternative segment occurs when, before receiving the optical test signal of the third type, the closest signal node of the particular normal segment receives the optical test signal of the first type (see claims 1-21 of US Patent No. 6,583,898).

Regarding claims 23 and 38, Koeppen discloses further comprising the step of: configuring the at least four test signal nodes as at least one of transit nodes, inception nodes and end nodes (see claims 1-21 of US Patent No. 6,583,898).

Regarding claim 24, Koeppen discloses further comprising the steps of providing the optical transmission device with at least one segment, the at least one segment including the at least one normal segment and the at least one alternative segment;

recognizing the disturbance of a particular segment of the at least one segment; and transmitting the optical test signal of the second type on all segments of the at least one segment excluding the particular segment (see claims 1-21 of US Patent No. 6,583,898).

Regarding claim 25, Koeppen discloses further comprising the step of: transmitting the optical test signals by the test signal node as a function of the optical test signals received by the test signal node (see claims 1-21 of US Patent No. 6,583,898).

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Regarding claim 26, Koeppen discloses further comprising the step of: influencing, via a superordinate control, the transmitting of the optical test signals by the test signal node (see claims 1-21 of US Patent No. 6,583,898).

Regarding claims 27 and 39, Koeppen discloses further comprising the step of: configuring the test signal nodes via a superordinate control (see claims 1-21 of US Patent No. 6,583,898).

Regarding claims 28 and 40, Koeppen discloses further comprising the step of: supplying information, via the test signal nodes to a superordinate control, relating to the optical test signals received by the test signal node (see claims 1-21 of US Patent No. 6,583,898).

Regarding claims 29 and 41, Koeppen discloses further comprising the step of: using a coupling node that adjoins the test signal node as a superordinate control (see claims 1-21 of US Patent No. 6,583,898).

Regarding claim 30, Koeppen discloses wherein the transmitting of useful optical signals is accomplished bidirectionally (see claims 1-21 of US Patent No. 6,583,898).

Regarding claims 31 and 37, Koeppen discloses wherein the step of transmitting the optical test signals includes the step of bidirectionally transmitting the optical test signals (see claims 1-21 of US Patent No. 6,583,898).

Regarding claim 32, Koeppen discloses wherein the bidirectionally transmitting of useful optical signals includes the step of using separate optical line fibers for bidirectionally transmitting useful optical signals (see claims 1-21 of US Patent No. 6,583,898).

Regarding claim 33, Koeppen discloses further comprising the step of: transmitting the optical test signals in both transmission directions together with transmitting the useful optical signals in a particular direction (see claims 1-21 of US Patent No. 6,583,898).

Regarding claim 34, Koeppen discloses a multiplex operation on each segment of the optical transmission device in each direction; and assigning to each transmitted useful signal its own optical test signal (see claims 1-21 of US Patent No. 6,583,898).

Regarding claims 35 and 42, Koeppen discloses further comprising the steps of: detecting a state "test signal not present" using a test signal level detector of the test signal node in response to an undershooting of a level of the optical test signal; and transmitting the test signal of the third type by the test signal node in at least one direction (see claims 1-21 of US Patent No. 6,583,898).

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 22-42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 22, 24, 35 and 36, the term "**first type**", "**second type**" and "**third type**" are vague and indefinite.

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Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Shiragaki (US Patent No. 5,663,820) discloses optical network using multiplexed payload and OAM signals.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hanh Phan whose telephone number is (571)272-3035.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Chan, can be reached on (571)272-3022. The fax phone number for the organization where this application or proceeding is assigned is (703)872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-4700.

A handwritten signature in cursive script, appearing to read 'Hanh Phan', is written over a horizontal line.

Hanh Phan

10/28/2004